

### **Remarks**

Reconsideration of the subject application in view of the present amendment is respectfully requested.

By the present amendment, claims 1, 3- 5, and 7-10 have been amended and claim 14 has been added. No new matter has been added.

Based on the foregoing amendments and the following remarks, the application is deemed to be condition for allowance, and action to that end is respectfully requested.

#### **I. Objection to the Specification**

The Examiner has objected to the specification based on certain informalities. The specification has been amended to overcome this objection. Accordingly, based on the above amendment, withdrawal of the objection to the specification is respectfully requested.

#### **II. Objection to the Claims**

The Examiner has objected to claims 1, 3-5 and 7-9 based on certain informalities. Such claims have been amended to overcome this objection. Moreover, regarding claim 1, the fastening element is introducible in a mounting opening of a hollow body. Further, the stop abuts the hollow body at its edges (5.1, 5.2) outwardly either directly (fig. 1a, 1b) or indirectly (fig,

8, 9). Regarding claim 3, the axial movement of the fastening means is a movement perpendicular to the stop which is a part of the fastening element. Accordingly, based on the above amendment and remarks, withdrawal of the objection to such claims is respectfully requested.

### **III. Rejection Over the Prior Art.**

The Examiner rejected claims 1-7 and 10-12 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,655,865 to Plank et al (Plank), and claims 1-6 and 10-12 as being anticipated by U.S. Patent No. 5, 489,173 to Höfle. Claims 8 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Plank and Höfle in view of U.S. RE 36,681 to Rinderer and claim 9 as being unpatentable over Plank and Höfle in view of Rinderer and further in view of U.S. Patent No. 6,086,300 to Fröhlich. It is respectfully submitted that claims 1-13 are patentable over the prior art, including all of the prior art of record in this application.

Plank et al. (US 5,655,865 A) refers to a fastening element having a rear grip member, a stop and a spring element which is fixed by pins with the stop and which is fixed by a snap-in-like connection by counter surfaces and projections arranged on the rear grip member (col. 3, line 44 - col. 4, line 6). By turning the fastening element (placed into a slot-like opening of an attachment rail) 90°, the entry inclines on the rear grip member move the rear grip member and the stop away from one another in the axial direction of the

attachment device (col. 4, lines 18-25). Such movement imparts a pre-stress of the spring element. After the rear grip member has reached the position for rear gripping, the free ends of the legs, the spring element urges the rear grip member into contact with the free ends (col. 4, lines 24-34) whereby the stop have to be turned for bring the rear grip member into a position for rear gripping the free ends of the legs.

Höfle (US 5, 489,173 A) refers to a fastening element comparable with the fastening element of Plank et al. (US '865) which has a different embodiment of the spring element. Similarly, in the fastening element according to Höfle (US '173), the connections between the spring element and the stop, on one side, and between the spring element and the rear grip part, on the other side, are always fixed.

Both references refer to fasteners whereby the stop is turned to bring the rear grip member into the second position. The stop and the rear grip member are always fixed by the spring element. These fasteners are made to receive a threaded rod of a pipe clamp.

In contradistinction, the rear grip member of the fastener element according to the invention is turned relative to the stop around the longitudinal axis of the fastener means by turning the fastener means, e.g. a

screw or a bolt. The spacer element is not predominantly a spring element like the spring elements according to Plank et al. (US '865) or to Höfle (US '173). Rather, the spacer element combines the function of a spring element and a coupling. In a first position, the spacer element secures a sufficient distance between the rear grip member and the stop that the rear grip member can be turned under the projections of the mounting rail and with the spring-loaded securing means the spacer element secures the correct position of the rear grip member until it has to be turned.

Neither Plank et al. (US '865) nor Höfle (US '173) teaches or suggests to one skilled in the art a fastening element, as claimed in pending claim 1 and claims 2-7 and 10-12 that depend therefrom.

A rejection based on U.S.C. § 102 as in the present case, requires that the cited reference disclose each and every element covered by the claim.

*Electro Medical Systems S.A. v. Cooper Life Sciences*, 32 U.S.P.Q. 2d 1017, 1019 (Fed. Cir. 1994); *Lewmar Marine Inc. v. Barient Inc.*, 3 U.S.P.Q. 2d 1766, 1767-68 (Fed. Cir. 1987); *Verdegaal Bros., Inc. v. Union Oil Co.*, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). The Federal Circuit has mandated that 35 U.S.C. § 102 requires no less than “complete anticipation . . .

[a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” *Connell v. Sears*,

Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems, 32 U.S.P.Q. 2d at 1019; Verdegaal Bros., 2 U.S.P.Q. 2d at 1053.

Since Plank et al. (US '865) and Höfle (US '173) each fail to disclose each and every feature of independent claim 1, such references, as a matter of law, each do not anticipate the present invention, as defined by said independent claim. In view of the above, it is respectfully submitted that Plank et al. (US '865) nor Höfle (US '173) each do not anticipate or make obvious the present invention as defined in claim 1, and claims 2-7 and 10-12 that depend therefrom and such claims are thus patentable over Plank et al. (US '865) and Höfle (US '173). Accordingly, allowance of claims 1-7 and 10-12 and withdrawal of the rejection to such claims under 35 U.S.C. §102(b) over Plank et al. (US '865) and Höfle (US '173) is respectfully requested.

It is respectfully submitted that claims 8 and 13 are patentable over Plank and Höfle in view of Rinderer and claim 9 is patentable over Plank and Höfle in view of Rinderer and further in view of Fröhlich.

Regarding paragraph 8, on pages 6 and 7 of the Office Action, it is submitted that contrarily to Examiner's opinion a reduction in interacting parts is very important for a fastening element as claimed. This fastening element is a mass-produced article and every simplification results in a

massive cost reduction. Moreover, an easy managing and a simple assembly is an important advantage on the hard-fought market of installation products. Thereby, the function and security in use have to be guaranteed. Therefore, when the function of the used elements performs a different function than before, the claimed fastening element does not involve a routine skill in the art.

Rinderer (US-RE 36,681 E) refers to a fastening element having a nut as a rear grip member and a retainer fixed with the nut (col. 6, lines 14-24). A plurality of resiliently deformable fin-like members is arranged circumferentially around the body except at two locations in a predetermined distance. The fin-like members are thin, planar and generally rectangular in shape (Col. 5, lines 53-55). A handle is attached at the retainer to aid in the turning of the nut (Col. 6, lines 57-60). Four teeth arranged on the nut penetrate the channel edges when a bolt is tightened (Col. 9, lines 17-20).

Rinderer (US-RE 36,681 E) refers to a different kind of fastening element and furthermore fails to disclose a spacer element as well as clips or brackets which are U-shaped. If one ordinary skilled in the art would have combined the fin-like members of Rinderer (US-RE 36,681 E) with a fastening element of Plank et al. (US '865) or to Höfle (US '173) such a combination would have lead him to a fastening element having a spring

element with circumferential arranged fin-like members. There is no hint or suggestion in any of these references to alter the fin-like members to a clip or bracket and arrange only two of them diametrically opposite each other.

Fröhlich (US 6,086,300 A) shows a clamping screw comprising a screw shaft and a hammer-shaped screw head having a socket for supporting the screw shaft. End faces of the socket secure an optimal mounting position of the clamping screw in a longitudinal slot of a mounting rail. The hammer-shaped screw head further has clamping portions which each support a clamping wedge.

A flat surface of the socket as a limitation of a rotation is another embodiment of a stop but is not comparable with an integrated stop of a clip or a bracket for clamping the fastening element to the holding projections of the mounting rail. Therefore, one of ordinary skilled in the art would not take this reference into account when searching for a solution for a new fastening element according to the invention. Furthermore, if one ordinary skilled in the art would take this reference into account, a combination with one of the cited references will not lead him to the claimed invention for the reasons mentioned above.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that the first element of *prima facie* obviousness has not been established.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

*In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir 1992) (footnote omitted) (emphasis in original). See also *In re Sernaker*, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983); *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Fine*, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in the cited references for the combination on which the Office Action relies. A statement that it would have been obvious to one skilled in the art to make modifications to the



references is not sufficient to establish a prima facie case of obviousness. MPEP §2143.01 relying on Ex Parte Levengood, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or influence in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” Id. at 1301 (emphasis in original).

The Court of Appeals for Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record as any *evidence*, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrived at the claimed invention. In re Jones 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992).

Ex Parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App & Inter. 1985) requires that when the references do not suggest the invention “. . . the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references.” No such line of reasoning is seen in the Office Action.

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the In re Fritch holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicants’ own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that that teachings of the prior should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obviously.” In *re Sponnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in Uniroyal v. Redkin-Willey, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . .

Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

There is nothing in the prior art that would suggest combining such references to achieve the claimed invention.

In view of the above, it is respectfully submitted that none of the references alone or in combination make the present invention, as defined in claim 1, obvious, and the present invention is patentable over such references.


Claims 8, 9 and 13 depend on claim 1 and are allowable for the same reasons claim 1 is allowable, and further because of specific features recited therein which, when taken alone and/or in combination with features recited in claim 1, are not disclosed or suggested in the prior art.

### **CONCLUSION**

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

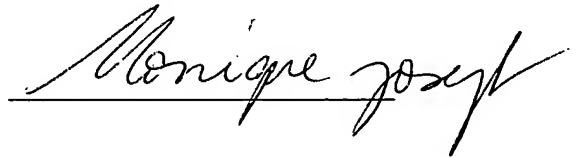
Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

  
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